

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

In the pending claims, claims 1, 3, 4 and 27 are amended, claims 14, 16, 17, 19 and 21 are canceled, and claim 48 is added.

a. Amendments to claims 1 and 27

Claims 1 and 27 are presently amended to recite that the feature substance is a carbon black, and that the optically variable material is a liquid crystal polymer. Support for the recitation of a carbon black material is found on page 4, second and third full paragraphs. Support for the recitation of the liquid-crystal polymer is found on page 5, third full paragraph. Therefore, no new matter is introduced by the amendment of claims 1 and 27.

In claim 1, the clause starting with “wherein the security element” is removed, and incorporated into new claim 48. Claims 3 and 4 are amended to depend from claim 48 in view of the removal of the clause from claim 1.

Entry of the amendment of claims 1, 3, 4 and 27, and new claim 48 is respectfully requested in the next Office communication.

b. Rejection of claims 3 and 17 under 35 U.S.C. § 112, second paragraph

Claim 3 is currently amended to qualify the expression “in register” with the expression “side by side.” With the expression “side by side,” the claim specifically conveys the particular location of the second printed layer relative to the first printed layer.

Claim 17 is canceled.

Withdrawal of the rejection of claim 3 is respectfully requested in the next Office communication.

2. Rejection of claims 1, 5, 14, 19 and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 6,036,232 (Kaule et al.)

In view of the amendment of claim 1, this rejection is respectfully traversed on the basis that the Kaule et al. patent fails to disclose or suggest a document of value having a feature substance that is a carbon black material in the form of a coding or alphanumeric information in combination with an optically variable material that is a liquid crystal polymer.

While the Kaule et al. patent broadly describes a plurality of materials that may be used to provide a background layer with authenticity features (col. 3, lines 8-15), it does not specifically disclose or suggest the simple use of a carbon black material. It follows that the Kaule et al. patent does not suggest the inventive step to combine a feature substance comprising a carbon black material with an optically variable material that is a liquid-crystal polymer.

In light of these observations, it is abundantly clear that the Kaule et al. patent does not disclose or suggest each and every feature of amended claim 1. Therefore, claim 1 is patentable. Claims 3, 4, 5, 9, 22 and 48, which depend from claim 1, are at least patentable based on their dependency from claim 1 and their individually recited features. Because of these observations, withdrawal of this present rejection is respectfully requested.

3. Rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,036,232 (Kaule et al.)

This rejection is respectfully traversed in view of amended claim 1, and the fact that indeed, contrary to the assertion the Office action, a first printed layer having a dark color imparts a mechanical effect and extends beyond mere ornamentation.

Particularly, the specification describes that a first printed layer having a dark color is advantageous in that if the feature substance used is a dark material, the dark background absorbs the radiation passing through the optically variable material as well as stray radiation (page 4, second full paragraph). This leads to the advantage that the optically variable effect of the optically variable layer is more apparent. On the contrary, if the first printed layer had a light color, the radiation would likely not be absorbed.

Therefore, it is readily apparent that the selection of a first printed layer having a dark color is more than a choice of ornamentation; it is to absorb radiation and to improve the optically variable effect of the optically variable layer.

In view of these observations, it is submitted that claim 4 is patentable over the Kaule et al. patent. Withdrawal of this rejection is kindly requested.

4. Rejection of claims 9, 16, 17, 22 and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,036,232 (Kaule et al.) in view of U.S. patent 6,183,018 (Braun et al.)

This rejection is respectfully traversed in view of the amendment to claim 1, wherein the Kaule et al. and Braun et al. patents, whether considered individually or collectively, fail to disclose or suggest a document of value having the features prescribed by claim 1. More specifically, these patents do not teach a document of value having a feature substance that is a carbon black material and is combined with an optically variable material that is a liquid-crystal polymer. Claims 9 and 22 depend from claim 1, and are patentable based on their dependency from claim 1 and their individually recited features.

Claim 27 is also amended to recite a feature substance that is a carbon black material, and an optically variable material that is a liquid-crystal polymer.

As indicated above, the Kaule et al. patent does not teach the aforementioned features of claims 1 and 27. The Braun et al. patent is provided for teaching an

optically variable material which can be comprised of an interference layer and a pigment. The Braun et al. patent, however, also is deficient in teaching the aforementioned features of both claims 1 and 27. As a result, it is respectfully submitted that one skilled in the art would not be motivated by the Kaule et al. and Braun et al. patents to make the document of value according to claim 1, and the multilayer transfer material according to claim 27.

The proposed combination of the Kaule et al. and Braun et al. patents, as applied against both claims 1 and 27, fails to establish a *prima facie* case of obviousness on the basis that these patents, whether considered individually or collectively, fail to teach each and every feature according to claims 1 and 27. It follows that one skilled in the art would not be motivated by the teachings in either the Kaule et al. or Braun et al. patents to make the document of value and the multilayer transfer material according to the pending claims. As a result, there would be no reasonable expectation of success in making the document of value and the multilayer transfer material according to the pending claims.

In view of these observations, withdrawal of this rejection is kindly requested on the basis that the proposed combination of the Kaule et al. and Braun et al. patents fails to establish *prima facie* obviousness of the pending claims.

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5. Conclusion

In view of the amendments of the claims and the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that the pending claims be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants's attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,



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